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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,721	07/16/2001	Hideki Asida	NAKI-BP02	9818

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01/02/2004

EXAMINER

MOHAMEDULLA, SALEHA R

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/857,721

Applicant(s)

ASIDA ET AL.

Examiner

Saleha R. Mohamedulla

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 17-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):  
a) ☒ All b) ☐ Some c) ☐ None of:  
1) ☐ Certified copies of the priority documents have been received.  
2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 100501 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restriction***

1. The Applicant's election of Group claims 1-16 is acknowledged. Because the Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-16 are considered by the Examiner.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US# 5,312,703 to Wagenblast et al.

Wagenblast teaches a process for making a metal electrode. Specifically, Wagenblast teaches a process for the reversible or irreversible production of an image by imagewise exposure of a recording layer to energy in the presence or absence of an electrical and/or magnetic field, resulting in a pattern of surface charges on the surface of the recording layer corresponding to the imagewise exposure to energy. The recording layer consists essentially of an organic material which solidifies in a glass-like manner, is non-photoconductive or

substantially non-photoconductive and contains permanent dipoles, in which the pattern of surface charges is produced without or substantially without the formation of free charge carriers by reversible imagewise alignment of at least some of the permanent dipoles present in the recording layer.

The process is advantageously carried out using an apparatus which comprises a suitable recording element, devices for imagewise exposure of the recording layer of the recording element to energy, and a counter-electrode which is in direct contact with the recording layer and can be removed therefrom. The pattern of surface charges produced by the process can be toned with liquid or solid toners. The resultant toner image can then either be fixed on the recording layer or transferred from the recording layer to another surface, after which the pattern of surface charges can be erased by exposing the entire surface to energy. A further image can then be produced. In this way, photocopies can be produced without the need to use the high-voltage sources which are necessary in conventional electrophotographic processes (Abstract).

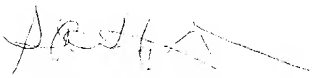
Wagenblast teaches that first a recording element is produced from a glass plate as the dimensionally stable carrier layer, a 0.7 micron thick, conductive, transparent electrode layer comprising indium/tin oxide (ITO), a rubbed polyimide layer produced in a conventional and known manner by spin-coating a 3% strength solution of a polyimide precursor Liquicoat.RTM. ZLI 2650 from Merck AG), drying the resultant wet layer, and baking the polyimide precursor layer at 300 degrees (col. 12, lines 35-55). The recording layer with a homogeneous planar alignment was then brought into direct contact, without being deformed, with an ITO electrode

layer (image electrode) which had been etched imagewise and had been produced in a conventional and known manner by imagewise etching of an ITO electrode over the entire surface on a glass plate and coating the resultant electrode image relief with a thin Teflon layer with antiadhesive properties (col. 13, lines 1-10).

Wagenblast does not specifically teach a second print, dry and exposure step, however, one of ordinary skill in the art would be motivated to include the second steps in order to form a any specific integrated circuit pattern that is within the design choice of one of ordinary skill in the art.

#### ***Conclusion***

3 Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Saleha Mohamedulla whose telephone number is (703) 308-1260. The Examiner can normally be reached Monday-Friday, from 8:00 AM to 4:30 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Huff, can be reached on (703) 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310. The After Final fax phone number is (703) 872-9311. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Saleha R. Mohamedulla  
Patent Examiner  
Technology Center 1700  
December 15, 2003